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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/303,510 04/30/99 COLLISSON

E 54954/JPW/TV

EXAMINER

HM12/1106

JOHN P WHITE
COOPER AND DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

WINKLER, II

ART UNIT

PAPER NUMBER

1648

DATE MAILED:

11/06/01

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/303,510

Applicant(s)

COLLISSON ET AL.

Examiner

Ulrike Winkler, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,48-52,55,56,62-64,83-85 and 90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,55,56 and 62-64 is/are allowed.
- 6) ☒ Claim(s) 48-52, 83-85 and 90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>17</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The request filed on 29 June 2001 (Paper No. 16) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/303,510 is acceptable and a CPA has been established after receiving the associate Power of Attorney on 7 September 2001 (Paper No. 20). An amendment has been filed 7 September 2001 (Paper No. 19) in response to the Office Action of 2 January 2001 is acknowledged and has been entered. Claims 6, 61, and 89 have been cancelled. Claims 2, 48-52, 62-64, 83-85 and 90 are pending and are currently being examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

The rejection of claims 2, 83, 89 and 90 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention **is withdrawn** in view of applicant's amendment to the claims removing the reference to the 70% homologous sequence and limiting the sequence to that disclosed in SEQ ID NO:5.

The rejection of claims 2, 6, 46, 48- 52, 55, 56, 62-64, and 83-85 under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (U.S Pat. No. 5,942,607) **is withdrawn** in view of applicant's amendment to the claims removing the reference to the 70% homologous sequence and limiting the sequence to that disclosed in SEQ ID NO:5 or 6.

Art Unit: 1648

The rejection of claim 2 and dependent claims 6, 83, 48-52, 55, 56, 62, 63, 64 and 83-85 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is **withdrawn** in view of applicant's amendment to the claims removing the reference to the 70% homologous sequence and limiting the sequence to that disclosed in SEQ ID NO:5 or 6.

The rejection of claim 2 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "at least about 70% homologous" is indefinite, the rejection is **withdrawn** in view of applicant's amendment to the claims removing the reference to the 70% homologous sequence and limiting the sequence to that disclosed in SEQ ID NO:5

The rejection of claim 2 and all the dependent claims 6, 48-52, 55, 56, 62-64, 83-85 under 35 U.S.C. 102(b) as being anticipated by Freeman et al. (WO9503408) is **withdrawn** in view of applicant's amendment to the claims removing the reference to the 70% homologous sequences.

The rejection of claim 2 under 35 U.S.C. 102(b) as being anticipated by Azuma et al. (WO9506738) is **withdrawn** in view of applicant's amendment to the claims removing the reference to the 70% homologous sequences and limiting the sequence to that disclosed in SEQ ID NO:5.

Art Unit: 1648

The rejection of claim 56 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention **is withdrawn** in view of providing a copy of the deposit receipt to ATCC showing that the deposits have been made in accordance with the Budapest treaty.

New rejections:

Claims 83, 84, 85 and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims use the phrase "shown in". This phrase is indefinite because it is not clear if applicant intends the whole sequence or just a portion of the sequence.

Claims 48-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims use the phrase "uniquely present"; this phrase is indefinite because it is not clear what applicant intends by this phrase. Does applicant use this phrase to distinguish sequences present in feline CD86 from other CD86 sequences? If so, applicant needs to be more specific what is included or excluded in a unique sequence, how many nucleotides in common can the sequence have and still be considered unique?

Art Unit: 1648

Claim 90 is objected to because of minor informality: The claim could be clarified by the following changes: An isolated nucleic acid consisting essentially of a nucleotide sequence which encodes a feline CD86 ligand or a soluble feline CD86 ligand of SEQ ID NO:6.

Applicant is not required to use the suggestion, however, applicant is required to make the claim clear and concise.

Conclusion

Claims 2, 55, 56, 62-64 are allowable.

Claims 48-52, 83-85 and 90 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

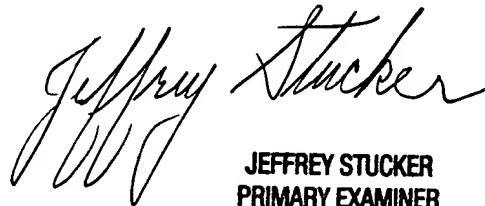
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 or for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Ulrike Winkler, Ph.D.



JEFFREY STUCKER
PRIMARY EXAMINER